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09/920,855	08/03/2001	Oliver O. Stanchfield	TPP 31390	6671

7590 09/08/2004  
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EXAMINER
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ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,855

Applicant(s)

STANCHFIELD, OLIVER O.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-15,27,28,30,32-34,36,37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-15,27,28,30,32-34,36,37,39-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/22/04 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 27, 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations (formed from compressed wood particles and a binder thereof) and “ the pad formed of a material different from the core) in claim 1, are new matter. There is no support for the added limitations in the original specification.

The limitation of lines 3-5 of claim 27 (...formed of....different from the core..” has the same problem as above.

Claim 37 lines 3, 8-9 “ formed....a binder”, “pad being formed...different from the core” has the same problem as above.

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***Specification***

4. The amendment filed 6/22/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “ the face 20 includes a surface layer 20A...a decor sheet”.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The disclosure is objected to because of the following informalities: page 5 line 1, should “25” be “ 26” instead?

Appropriate correction is required.

***Drawings***

6. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawing submitted 6/22/04 contains new matter and needs to be corrected. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: numeral “ 25” to the space. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet

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should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 9-10, 13, 36, 37, 39, 40, 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santarossa (6253510) in view of Margarit.

Santarossa shows a molding having a longitudinal axis (figure 1, along the length of the molding), a core (5), a surface formed of a thermosetting resin and a décor sheet (col 3 lines 1-10), the molding having a generally planar floor engaging surface (the surface of the core that mates with the surface of the pad 10, figure 1 top), a wall engaging surface (the surface of the core that mates with the surface of the pad 10, figure 1 bottom) positioned substantially perpendicular to the floor engaging surface, a pad (elongated mounting surface 10) coupled to the floor engaging surface (the pad is a wrap around of the surface and is thus coupled thereto),

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the pad formed of a material different from the core, the pad resiliently creates a substantially moisture tight seal so as to prevent moisture from seeping between the floor and the molding when the molding is in an installed positioned (the finish and base coating being resilient and flexible), an adhesive (2) positioned on the pad, an intermediate surface (8) connecting the wall and floor engaging surfaces (3,4), the intermediate surface being angled so that the three engaging surfaces forming a generally triangular shape in a plane transverse to the longitudinal axis, a face on the molding and positioned to face outwardly from the corner, the face being at least one curve section, the pad being positioned distal a front edge (the edge closer to the corner) of the floor engaging surface, the front edge of the floor engaging surface is distal the corner (formed by 3, 4), the molding having a generally uniform cross section at planes transverse to the longitudinal axis, glue (2) being applied immediately to the pad before placing the molding in the installed condition, the pad being adjacent to the floor engaging surface, the décor sheet comprises a color or pattern adapted to be complementary to an upper surface of a floating floor.

Santarossa does not show the core formed from compressed wood particles and a binder therefor.

Santarossa discloses wood molding being a commonly used molding (col 1 lines 22-25).

Margarit discloses a molding made of high density fiberboard (col 7 lines 15-26, col 2 lines 4-7).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Santarossa to show the core being formed from compressed wood particles and a binder as taught by Margarit because it is well known to have wood molding as taught by

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Santarossa and having the core being formed from compressed wood particles and a binder would enable material cost saving per the availability of cheap wood particles and binder, and forming the core with wood particles and a binder also enables easy forming of a variety of shapes and sizes of the molding as it requires only the change in the size and shape of the die.

3. Claims 3, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santarossa (6253510) in view of Margarit as applied to claim 1 above and further in view of DeGraan (4655009).

Santarossa as modified shows all the claimed limitations except for the molding having a wall engaging surface with apertures therein to allow a connector to pass therethrough.

DeGraan shows a molding having a wall engaging surface with apertures therein to allow a connector(26) to pass therethrough to anchor the molding to the wall in addition to the adhesive (19).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Santarossa's modified structure to show the molding having a wall engaging surface with apertures therein to allow a connector to pass therethrough because it would further enhance the fastening of the molding to a wall in addition to adhesive as taught by DeGraan.

4. Claims 1-2, 11, 36-37, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keith (3982780) in view of Margarit (5979132).

Keith (figure 5) shows a molding having a longitudinal axis (along the length of the molding), a core (5), a surface formed of a thermosetting resin and a décor sheet (56), the molding having a generally planar floor engaging surface(the surface at the bottom of part 51), a wall engaging surface (52a) positioned substantially perpendicular to the floor engaging surface

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(inherently so as the surface is to attached to surfaces from 0-90°), a pad (55) coupled to the floor engaging surface, the pad formed of a material different from the core, the pad resiliently creates a substantially moisture tight seal so as to prevent moisture from seeping between the floor and the molding when the molding is in an installed positioned, an adhesive (54) positioned on the pad and configured to engage the floating floor when the molding is in the installed position, the pad is formed of a material that is a resilient material made from one of a closed cell foamed plastic material or an open cell, foamed plastic material.

Keith does not disclose the core being made of compressed wood particles and a binder thereof.

Margarit discloses a molding made of high density fiberboard (col 7 lines 15-26, col 2 lines 4-7).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Keith's core to show the core being formed from compressed wood particles and a binder as taught by Margarit because having the core being formed from compressed wood particles and a binder would enable material cost saving per the availability of cheap wood particles and binder, and forming the core with wood particles and a binder also enables easy forming of a variety of shapes and sizes of the molding as it requires only the change in the size and shape of the die.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keith (3982780) in view of Margarit (5979132) as applied to claim 11 above and further in view of Strasser.

Keith as modified shows all the claimed limitations except for the pad having a hollow formed therein.



Strasser (figure 4) discloses a hollow in the core to reduce weight of the core.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Keith's modified structure to show a hollow formed in the pad because it would reduce the weight of the foam structure as taught by Strasser and increase the resiliency of the pad.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keith (3982780) in view of Margarit (5979132) as applied to claim 1 above and further in view of Madonia et al (4546022).

Keith as modified shows all the claimed limitations except for the pad including a preformed layer of adhesive wherein a removable film covers the adhesive.

Madonia et al shows a pad (37) including a preformed layer of adhesive wherein a removable film (39) covers the adhesive to enable easy quick bonding of the pad to another structure at the time of the usage.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Keith's modified structure to show the pad including a preformed layer of adhesive wherein a removable film covers the adhesive because it would enable easy and quick bonding of the pad to another structure at the time of usage as taught by Madonia et al.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Santarossa (6253510) in view of Margarit (5979132).

Santarossa as modified shows all the claimed limitations except for a floating floor.

Margarit discloses a floating floor with a molding for covering the floating floor.

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It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Santarossa's modified structure to show the molding being used with a floating floor as taught by Margarit because it is well known in the art to use a molding to cover a floating floor and wall joint.

8. Claims 27-28, 30, 32-34, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keith (3982780) in view of Margarit (5979132).

Keith as modified shows all the claimed limitations including a sealant (the adhesive 54) except for a floating floor attaching to the floating floor surface.

Margarit further discloses a molding used to connect a floating floor and a wall.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Keith's modified structure to show a floating floor as taught by Margarit because it is well known in the art to cover the corner of a floating floor and a wall with a molding as such covering will provide an aesthetic appearance to the corner.

Keith as modified shows all the claimed limitations. The claimed method steps would have been the obvious method steps of preventing moisture from into a gap between a floating floor and a molding would have been the obvious method steps of preventing moisture with Keith's modified structure.

Per claim 33, Keith as modified shows all the claimed limitations except for the sealant being a silicone sealant.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Keith's modified structure to show the sealant being a silicone sealant

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because having an adhesive made of silicone would ensure the adhesive still functions when wet and thus ensuring the attachment of the molding to the substructure.

Keith as modified shows all the claimed limitations. The claimed method steps would have been the obvious method step of preventing moisture from seeping into a gap between a floating floor and a molding with Keith's modified structure.

### ***Response to Arguments***

**The response to argument to the merits of the claims are pending per applicant's response to the 112 new matter issues above.**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

9/3/04